

REMARKS

Claims 29, 30, 41, 42, 49 and 50 are pending in this application, with claim 29 being independent. Claim 29 has been amended. Favorable reconsideration is respectfully requested.

The Office Action requires restriction between the following Groups of claims:

- I. Claims 29, 30, 41 and 42, drawn to a process of making a single electron-emitting device, classified in class 29, subclass 846; and
- II. Claims 49 and 50, drawn to a process of forming multiple electron-emitting devices, classified in class 29, subclass 832.

According to the Office Action, Groups I and II are related as mutually exclusive species in an intermediate-final product relationship because “the intermediate product (Group I) is deemed to be useful as a single electron-emitting device in a circuit board application without the need for multiple electron-emitting devices and without any light-emitting member, and the two inventions are deemed patentably distinct since there is nothing on this record to show them to be obvious variants” (Office Action at 2) (emphasis in original). The Office Action cites MPEP §§ 806.04(b) and 806.04(h) in support of the restriction requirement. According to the Office Action, because an action treating the Group I claims on the merits already has been issued, those claims have been constructively elected and claims 49 and 50 have been withdrawn from consideration.

Applicant respectfully submits that the basis for the restriction requirement is improper. According to Applicant’s understanding, MPEP § 806.04(b) relates to species

that may be related, not to claims. That is, MPEP § 806.04(b) is applicable only in a case where inventions as disclosed and claimed are both (A) species under a claimed genus and (B) related. Also, MPEP § 806.04(e) states that “Claims are definitions of inventions[, but] *are never species.*”

In the Office Action, only groups of claims are identified, but no species of supposedly related inventions are pointed out, let alone characterized as encompassing any of the Group I and II claims. The Office Action also does not identify any claimed genus under which any such species would belong.

Moreover, the intermediate-final product restriction requirement apparently is applicable only with respect to product inventions. *See* MPEP § 806.04(b). The pending claims, in contrast, are method claims, and MPEP § 806.04(b) therefore cannot apply.

Accordingly, Applicant respectfully requests withdrawal of the restriction requirement, and respectfully requests that claims 49 and 50, which have been withdrawn from consideration, be considered along with claims 29, 30, 41 and 42.

Claims 29, 30, 41 and 42 2343 rejected under 35 U.S.C. §102(b) as anticipated by U.S. Patent 5,866,195 (*Lemelson*). This rejection is respectfully traversed.

Independent Claim 29 relates to an electron-emitting device manufacturing method that includes a gas removal step of removing a gas dissolved in a liquid containing a formation material of an electroconductive film in which an electron- emitting area is to be formed, and a temperature adjusting step of adjusting a temperature of the liquid from which the gas is removed. A droplet discharge step discharges droplets of which the temperature is adjusted by droplet discharge means in an ink jet manner while controlling

relative positions of the droplet discharge means for discharging droplets of the liquid and a substrate on which the electroconductive film in which the electron-emitting area is to be formed, is formed, thereby applying the droplets to a predetermined position on the substrate.

The method of claim 29 also includes a step of heat processing the liquid applied to form the electroconductive film, and a step of energization processing the electroconductive film. And in Claim 29, the liquid passes a liquid storage tank, a gas removing device, and a temperature adjusting device, sequentially and in that order, and thereafter is introduced into a liquid discharge means operating in the ink jet manner.

The important features discussed above are neither taught nor suggested by *Lemelson*. *Lemelson* relates to methods for forming diamond-coated superconductor wire. As is shown in Fig. 15 of *Lemelson*, an elongated metal wire 111 is fed from a coil and driven into and through a chamber 114. Gaseous and/or vaporous chemicals are admitted into the chamber through inlet 118, which is situated near where the wire enters. Situated throughout the chamber group are deposition heads 115A through 115N which direct selected streams of the gaseous or vaporous chemicals against the outer surface of the wire. Means 117 are also situated in this chamber, for generating and directing microwave radiation against the gas or vapor. Near where the wire exits the chamber, an outlet duct 119 is provided to permit controlled removal of liquid or gas.

As can be readily seen, in view of the configuration of *Lemelson*, many of the salient features of the method of claim 29 could simply not be carried out. For example, the gas enters into the chamber near where the wire enters, the deposition heads

are situated along the wire's path and the radiation means are situated on either end of the chamber. And, the gas is removed near where the wire exits. With this arrangement, it is simply not possible to have liquid pass a storage tank, a gas removing device and a temperature adjusting device, sequentially and in that order, and thereafter be introduced into a liquid discharging means. Absent that important feature, *Lemelson* cannot possibly be said to anticipate claim 29.

For these reasons, claim 29 is believed to be clearly patentable over *Lemelson*. Accordingly, withdrawal of the Section 102 rejection of that claim is respectfully requested.

A review of the other art of record, has failed to reveal anything which, in Applicant's view, would remedy the deficiencies of the art discussed above as a reference against claim 29. That claim is therefore believed patentable over the art of record.

The other claims in this application (including claims 49 and 50 which the Office Action withdrew from consideration, but which Applicant believes should be considered) are each dependent from independent claim 29 discussed above and are therefore believed patentable for the same reasons as is claim 29. Since each dependent claim is also deemed to define an additional aspect of the invention, however, the individual consideration or reconsideration, as the case may be, of the patentability of each on its own merits is respectfully requested.

CONCLUSION

In view of the foregoing amendments and remarks, Applicant respectfully requests favorable reconsideration and early passage to issue of the present application.

Applicant's undersigned attorney may be reached in our New York office by telephone at (212) 218-2100. All correspondence should continue to be directed to our below listed address.

Respectfully submitted,



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